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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>11 March 2009</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-25</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-25</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☒ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>22 December 2008</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   This action is in reply to the amendment filed on 11 March 2009.

2.   Claims 1, 8-9, 13, 14 and 18-19 have been amended.

3.   Claims 1-25 are currently pending and have been examined.

Continued Examination Under 37 CFR 1.114

4.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection.   Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 March 2009 has been entered.

Information Disclosure Statement

5.   The Information Disclosure Statement filed on 22 December 2008 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Specification

6.   The substitute specification filed 20 August 2008 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: the substitute specification goes beyond correcting idiomatic English issues and (1) adds definitions that were not previously part of the original disclosure (see at least page 10, lines 17-19 and 23-25) and (2) changes some terms creating new terms that were not part of the original disclosure and are not defined or differentiated from the previous similar terms (see at least page 21, lines 17 and 18). Specifically (regarding (2) above) the claim limitation 'predetermined reference information' is not explicitly defined in the specification, however the original disclosure does refer to 'predetermined reference/s' throughout

the specification and in some cases discusses the composition of these references. Applicant's substitute specification changes nearly every instance of 'predetermined reference' in the specification to 'predetermined criteria.' Examiner is not convinced that reference and criteria are synonyms and has not been appraised by Applicant as to why this change was determined necessary to the purpose of correcting grammatical mistakes to put the disclosure into proper idiomatic English. Further this amendment appears to further differentiate the 'predetermined reference information' of the claims from the 'predetermined criteria' (formerly 'predetermined reference') now in the specification. This leaves Examiner wondering what the claimed 'predetermined reference information' is since there is no longer anything resembling an explanation or definition for this limitation in the specification.

7.   There are still further examples throughout the substitute specification where Applicant's amendments go beyond correcting grammar to actually making substantive changes (see at least (3) page 29, line 3, and (4) page 30, line 8). At page 29, (regarding (3) above) Applicant amends the sentence 'a keyword which is the user's access intention' to 'a keyword which is associated to a user's access intention.' This is not a mere grammatical correction and it changes the definition of 'keyword' and 'access intention.' The original disclosure indicates that an 'access intention' is determined at step 330 and similarly (although apparently in an unrelated step) 'an interested field of the user' is determined at step 250, but the specification does not explain how this determination is made. Definitions like the former definition of page 29 lead the Examiner to interpret that the invention determines the 'access intention' and 'interested field of the user' to be the keyword a user enters. After the amendment to that definition, Examiner no longer knows how to define 'access intention,' or how it is derived; only that it is somehow broadly associated with the keyword. On page 30 (regarding (4) above) Applicant removes the word 'sold' in favor of the word 'purchased' this change is more substantive than a grammatical change. The actions of selling and purchasing are related, but this substantively changes this portion of the disclosure. This particular sentence remains difficult to interpret because there is no identified subject doing the analysis, rather the 'request is analyzed.' But the request used to be a request for data to sell,

and now it is a request for data to purchase, suggesting that the subject doing the requesting action has changed with this amendment.

8.   In light of these issues (and Examiner notes that the list of issues (1-4) indicated above is not an exhaustive list of issues, but rather a list of several examples), Examiner objects to the substitute specification because it adds new matter to the disclosure and therefore the new specification will not be entered. Further Examiner continues to struggle with Applicant's broad terminology in the claims especially in light of Applicant's inconsistent use of the same terminology in the specification (as demonstrated above) and the lack of explicit definitions in the specification. This matter is particularly poignant upon consideration of Applicant's remarks to the final Office action of 23 October 2008 in which Applicant referrers to a dictionary to define a claim term that was identified as new matter (i.e. the Applicant is forced to look outside the disclosure to define claim terms) and in which Applicant describes in concise language an invention strikingly different from the invention described in both the original specification and the substitute specification.

Claim Rejections - 35 USC § 112

9.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10.   Claims 1, 8, 13, 14, 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claims 1, 18 and 19 presently recite *the history data represents use information by the user of the keyword*, *the type information defines pattern characteristics of the keyword*, and *the predetermined reference information is comprised of several conditions specific to each type information in the keyword database*. These limitations are absent from the original disclosure.

These limitations both add new definitions to existing claim limitations (i.e. further defining *history data, type information* and *predetermined reference information*) and also add additional limitations to the claims that were never part of the original disclosure and are not defined by the original disclosure (i.e. *use information* and *pattern characteristics*). Examiner can find no support for these new limitations in the original disclosure; the new limitations constitute impermissible new matter. Claims 8, 13 and 14 presently recite *the advertisement request is a request for purchasing the advertisement keyword by the first sponsor.* This limitation is absent from the original disclosure and further appears to contradict the original disclosure. The original disclosure fails to explicitly define *advertisement request*, but does discuss the *advertisement request* on at least page 22 lines 4-6 describing figure 8. In that section the original disclosure states "the collected information is provided to the sponsor who has made the advertisement request, and the sponsor determines whether to purchase the relevant keyword with reference to the above information." This indicates to examiner that the *advertisement request*, at least at the time the application was filed, was not the same as a purchase request because the specification states that the purchase request occurred after the *advertisement request* was made, and after further information was sent to the sponsor that made the request. Examiner can find no support for this new limitation in the original disclosure; the new limitation constitutes impermissible new matter.

11.   Claims 8, 13 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. This rejection is maintained; see the response to arguments section below. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claims 8, 13 and 14 presently recite *evaluation data*, however *evaluation data* is absent from both the original disclosure. Applicant is reminded that MPEP §2111 instructs that the broadest reasonable interpretation is applied to claim language and limitations from the specification are not to be read into the claims absent a clear and explicit definition. In this case Applicant's specification does not

support the narrow reading of *evaluation data* that Applicant suggests in Applicant's remarks (see

pages 14 and 15 of Applicant's remarks).

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as
set forth in section 102 of this title, if the differences between the subject matter sought to be
patented and the prior art are such that the subject matter as a whole would have been obvious
at the time the invention was made to a person having ordinary skill in the art to which said
subject matter pertains. Patentability shall not be negatived by the manner in which the invention
was made.

13.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966),

that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or
        nonobviousness.

14.   Claims 1-7, 18-20 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Nam et al. (WO 02107030 A1) alone.

Claims 1, 18, 23, 24 and 25:

Berstis, as shown, discloses the following limitations:

•   *maintaining a keyword database for recording multiple keywords, type*

information of the keyword, predetermined reference information that

corresponds to the type information, and advertisement list information that

corresponds to the keyword, in which the advertisement list information

includes a number of advertisement files that include the keyword (see at

least page 8, line 10-12, a database that may be indexed by "key" - note that

this patent uses the phrase "key word" and "key" rather than keyword),

- *receiving a predetermined event from a user, wherein the predetermined event is an action taken by the user while utilizing the internet* (see at least Figure 5, Item 501, see also at least page 11, lines 5-14, input server address, input search keywords),

- *recording a keyword as history data that corresponds to the received predetermined event, from the user, wherein the history data represents use information by the user of the keyword* (see at least page 11, lines 10-12, the input is stored in a table and previously stored information based on the keyword is retrieved and stored in the same table),

- *searching for the type information of the keyword by referring to the keyword database, wherein the type information defines pattern characteristics of the keyword* (see at least page 11, lines 5-12, information about the characteristics of the page or the inputted keyword are transmitted to the advertising server, the advertisement server gathers this information and stores it in the database; this data is later retrieved/searched upon input of the keyword to generate the advertisement table),

- *searching for the predetermined reference information that corresponds to the type information of the keyword, wherein the predetermined reference information is comprised of several conditions specific to each type information in the keyword database* (see at least page 16, lines 9-12, advertisements may be classified according to directories requested by the advertiser (i.e. predetermined) and the ads are displayed after searching the directories using the keyword; Examiner notes that the reference to random display in this section assumes that more than one ad exists in the same subdirectory),

- *determining whether the keyword is an interested field of the user in view of the predetermined reference information* (see at least Table 1, this invention

pre-stores information about each user including users fields of interest; see also at least page 10, lines 13-14, advertisements may be presented based on both the user's field of interest and the characteristics of the page; Examiner notes, based on the above disclosure that characteristics of the page are include keywords derived from the page as well as characteristics associated with keywords; see further at least page 11, lines 5-15, the site that the user navigates to or the search input of the user are retrieved in the form of keywords, these keywords are assumed to be an *interested field of the user* since the user actively entered them),

- *generating an advertisement file including the keyword that is determined to be the interested field of the user* (see at least page 11, lines 10-11, the advertisement table is generated based on the information and the input),

- *updating a number of advertisement files in the advertisement list information stored in the keyword database* (see at least page 6, liens 13-14, the advertisement server stores the advertisement tables, here the advertisement file is the advertisement table; see also at least page 15, lines 6-11, searching a cookie (i.e. a cookie that is pre-stored) corresponding to the keyword, here the advertisement file is a cookie),

- *generating advertisement information including the keyword and the advertisement list information updated with the number of advertisement files* (see at page 15, lines 23-25, the click information is stored in the cookie; see also at least page 16, lines 16-24, further generation and reference to advertisement information; see also at least page 17, lines 27-29, advertisement statistics can be collected according to an advertising site; Examiner notes that, as demonstrated above, the site that a user navigates to may be used as the keyword to look-up relevant advertising, thus advertisement statistics may be keyed to keywords),

Examiner notes that although the reference teaches each limitation as shown in the rejection above, the reference discloses many elements with reference to several separate embodiments. However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the various elements among the disclosed embodiments since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 2:

Nam discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitation:

- *the predetermined event is one among a keyword inputted at a search window of an Internet search engine by the user, a web page address inputted at an address window of a web browser by the user, and a hypertext markup language link selected on the web browser by the user* (see at least page 3, line 12, inputting a website address).

Claim 3:

Nam discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitation:

- *the type information of the keyword is a predetermined effective period set in advance for each keyword* (see at least page 16, lines 18-20).

Claim 4:

Nam discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitation:

- *the predetermined reference information is a number of times the predetermined event is inputted from the user during the predetermined effective period* (see at least page 16, line 20-21).

Claim 5:

Nam discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitation:

- *the advertisement file is a cookie file* (see at least page 12, line 20-21).

Claim 6:

Nam discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitation:

- *the advertisement file includes at least one of a terminal number (PC ID) of the user, an identifying symbol of the user, expiration data of the advertisement file* (see at least page 17, lines 5-8, identifying information of the user is stored).

Claim 7:

Nam discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitation:

- *the advertisement information additionally includes a number of impressions of a web page that corresponds to the keyword* (see at least page 16, line 20-21).

Claim 19:

Nam, as shown, discloses the following limitations:

- *a keyword database recording multiple keywords, type information of the keyword, predetermined reference information that corresponds to the type information, advertisement list information that corresponds to the keyword, in which the advertisement list information includes a number of advertisement files that include the keyword, wherein the type information defines pattern characteristics of the keyword and the predetermined reference information is comprised of several conditions specific to each type information in the keyword database* (see at least page 8, line 10-12, a

database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),

- *a communication part receiving a predetermined event from a user, wherein the predetermined event is an action taken by the user while utilizing the internet* (see at least Figure 5, Item 501, see also at least page 11, lines 5-14, input server address, input search keywords),

- *a processing part recording a keyword as history data that corresponds to the received predetermined event from the user* (see at least page 11, lines 10-12, the input is stored in a table and previously stored information based on the keyword is retrieved and stored in the same table),

- *searching for the type information of the keyword and the predetermined reference information that corresponds to the type information of the keyword by referring to the keyword database* (see at least page 11, lines 5-12, information about the characteristics of the page or the inputted keyword are transmitted to the advertising server, the advertisement server gathers this information and stores it in the database; this data is later retrieved/searched upon input of the keyword to generate the advertisement table; see also at least page 16, lines 9-12, advertisements may be classified according to directories requested by the advertiser (i.e. predetermined) and the ads are displayed after searching the directories using the keyword; Examiner notes that the reference to random display in this section assumes that more than one ad exists in the same subdirectory),

- *determining whether the keyword is an interested field of the user according to the predetermined reference information and type information of the keyword searched in the keyword database, wherein the history data represents use information by the user of the keyword* (see at least Table 1, this invention pre-stores information about each user including users fields of

interest; see also at least page 10, lines 13-14, advertisements may be presented based on both the user's field of interest and the characteristics of the page; Examiner notes, based on the above disclosure that characteristics of the page are include keywords derived from the page as well as characteristics associated with keywords; see further at least page 11, lines 5-15, the site that the user navigates to or the search input of the user are retrieved in the form of keywords, these keywords are assumed to be an *interested field of the user* since the user actively entered them),

- *an advertisement file preparing part extracting the keyword determined to be the interested field of the user and generating an advertisement file including the extracted keyword, in which the advertisement file includes at least one of a user's terminal number (PC ID), an identifying symbol of the user, and expiration date information of the advertisement file* (see at least page 11, lines 10-11, the advertisement table is generated based on the information and the input, see also at least page 17, lines 5-8, identifying information of the user is stored),

- *an advertisement information generating part updating a number of advertisement files in the advertisement list information stored in the keyword database and generating advertisement information including the keyword and the advertisement list information updated with the number of advertisement files* (see at least page 6, liens 13-14, the advertisement server stores the advertisement tables, here the advertisement file is the advertisement table; see also at least page 15, lines 6-11, searching a cookie (i.e. a cookie that is pre-stored) corresponding to the keyword, here the advertisement file is a cookie),

- *an advertisement database storing multiple keywords and multiple advertisement data that corresponds to the keyword* (see at least page 8, line

10-12, a database that may be indexed by "key" - note that this patent uses

the phrase "key word" and "key" rather than keyword),

- *an advertisement transmitting part processing the advertisement data that*
  corresponds to the keyword included in the advertisement file by referring to
  the advertisement database, and providing the advertisement data that is
  processed to a web browser of the user (see at least page 12, lines 26-28,
  the searched ad is sent to user display device),

- *a storing part storing history information with respect to the providing of the*
  advertisement data to the user (see at least page 12, line 30 continuing to
  page 13, line 1, whether the ad loads properly is confirmed and recorded),

- *an analyzing part providing predetermined feedback information to a sponsor*
  who has registered the advertisement data, according to the history
  information (see at least page 17, lines 27-29, statistics of ad information
  may be collected by advertiser or advertiser site on a regular basis).

Examiner notes that although the reference teaches each limitation as shown in the

rejection above, the reference discloses many elements with reference to several

separate embodiments. However, it would have been obvious to a person having

ordinary skill in the art at the time the invention was made to combine the various

elements among the disclosed embodiments since the claimed invention is merely a

combination of old elements, and in the combination each element merely would have

performed the same function as it did separately, and one of ordinary skill in the art would

have recognized that the results of the combination were predictable.

Claim 20:

Nam discloses the limitations as shown in the rejection above. Further, Nam, as shown,

discloses the following limitation:

- *the advertisement list information additionally includes a number of impressions of a web page that corresponds to the keyword* (see at least page 16, line 20-21).

15.   Claims 8-17, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nam et al. (WO 02107030 A1) in view of Cheung et al. (US 7,043,471 B2).

Claim 8:

Nam, as shown, discloses the following limitations:

- *maintaining a keyword database for storing multiple keywords and advertisement information according to the keywords* (see at least page 8, line 10-12, a database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),

- *receiving a first advertisement request that includes an advertisement keyword from a first sponsor, wherein the advertisement keyword corresponds to one of the multiple keywords stored in the keyword database* (see at least page 13, line 20-21, see also page 11, lines 5-25, advertising corresponds to the keywords, see also page 8, advertisement and corresponding key),

- *searching for the advertisement information that corresponds to the advertisement keyword by referring to the keyword database* (see at least page 3, line 26, see also page 11, lines 5-25, advertising corresponds to the keywords),

- *if there is no advertisement information corresponding to the advertisement keyword in the keyword database, recording the received advertisement keyword* (see at least Figure 1, items 118 and 119, the advertisement database stores ads and keywords and advertisement server stores tables that enable the invention to search the ad database and select and transmit the ads),

- *recording, in a first advertisement database, the advertisement keyword and the first advertisement data from the first sponsor that corresponds to the advertisement keyword* (see at least Figure 1, items 118 and 119, the advertisement database stores ads and keywords and advertisement server stores tables that enable the invention to search the ad database and select and transmit the ads),

Nam does not specifically disclose the following limitation. However, Cheung, as shown, discloses the following limitations:

- *an input counter value for the advertisement keyword in a predetermined storing means* (see at least column 6, lines 48-51, ad rank; see also at least, column 8, lines 31-44, seniority),

- *receiving a first advertisement request that includes an advertisement keyword from a first sponsor, wherein the advertisement keyword corresponds to one of the multiple keywords stored in the keyword database* (see at least column 6, line 48-51, the advertiser associates the ad with the desired keywords, keywords may or may not be in use, ad is ranked based on relative price paid for the selected keyword/s),

- *the advertisement request is a request for purchasing the advertisement keyword by the first sponsor* (see at least column 6, lines 48-51, the advertiser 'purchases' the keyword by submitting a bid which is paid whenever the ad is displayed/clicked based on the keyword),

- *processing the advertisement information that corresponds to the advertisement keyword and providing evaluation data of the advertisement keyword to a web browser of the first sponsor* (see at least column 23, lines 22-55, "project expenses" feature of this invention predicts based on the advertisement keyword the response that an advertiser can expect, i.e. the number of clicks, and predicts the cost of the advertising campaign for the

> advertiser based on a cost per click payment scheme; Examiner notes that
> this prediction mechanism requires a determination of expected clicks based
> on previous data and keyword),
>
> • *receiving a purchase response from the first sponsor, in which the purchase*
>   *response includes first advertisement data of the first sponsor* (see at least
>   column 6, line 48-51, generally describing bidding for keywords in a search
>   engine advertising setting and advertiser providing payment for the ad),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine a bidding feature with the advertising invention of Nam because Cheung discloses that a better way to control advertising costs while maximizing advertising exposure is needed and endorses bidding price strategies that allow the advertisers to set the appropriate price for an ad thereby alleviating the costly effects of an arbitrary pricing strategy. Examiner notes that although the Cheung invention is focused on alleviating costs further in the advertising chain, i.e. controlling click-through costs, the per ad/click costs/rates in the Cheung invention are initially derived from bidding.

Claim 9:

The combination Nam/Cheung discloses the limitations as shown in the rejections above. Further, Cheung, as shown, discloses the following limitations:

> • *if a second advertisement request including the advertisement keyword is*
>   *received from a second sponsor, increasing the input counter value for the*
>   advertisement keyword recorded in the storing means (see at least, column
>   8, lines 31-44, seniority, the second ad request for the same keyword will
>   have a lower seniority than the first; however ad placement will still vary
>   depending on the bid rank),
>
> • *determining whether the input counter value is greater than a predetermined*
>   *value if the input counter value is greater than the predetermined value,*

recording, the advertisement keyword and advertisement information that corresponds to the advertisement keyword in the keyword database (see at least column 6, line 48-51, the advertiser associates the ad with the desired keywords, keywords may or may not be in use, ad is ranked based on relative price paid for the selected keyword/s),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine a bidding feature with the advertising invention of Nam because Cheung discloses that a better way to control advertising costs while maximizing advertising exposure is needed and endorses bidding price strategies that allow the advertisers to set the appropriate price for an ad thereby alleviating the costly effects of an arbitrary pricing strategy. Examiner notes that although the Cheung invention is focused on alleviating costs further in the advertising chain, i.e. controlling click-through costs, the per ad/click costs/rates in the Cheung invention are initially derived from bidding.

Claim 10:

The combination Nam/Cheung discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitation:

- *wherein the evaluation data includes at least one of information for a number of generated advertisement files, information for a number of impressions of a web page corresponding to the advertisement keyword, price information of the advertisement keyword (*see at least page 16, line 20-21).

Claim 11:

The combination Nam/Cheung discloses the limitations as shown in the rejection above. Nam does not specifically disclose the following limitation. However, Cheung, as shown, discloses the following limitation:

- *the purchase response additionally includes payment information for a predetermined advertisement charge* (see at least column 6, line 48-51,

generally describing bidding for keywords in a search engine advertising setting and advertiser providing payment for the ad),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine a bidding feature with the advertising invention of Nam because Cheung discloses that a better way to control advertising costs while maximizing advertising exposure is needed and endorses bidding price strategies that allow the advertisers to set the appropriate price for an ad thereby alleviating the costly effects of an arbitrary pricing strategy. Examiner notes that although the Cheung invention is focused on alleviating costs further in the advertising chain, i.e. controlling click-through costs, the per ad/click costs/rates in the Cheung invention are initially derived from bidding.

Claim 12:

The combination Nam/Cheung discloses the limitations as shown in the rejection above. Nam does not specifically disclose the following limitation. However, Cheung, as shown, discloses the following limitation:

- *the advertisement request is performed in a manner of auction or bidding* (see at least column 6, line 48-51, generally describing bidding for keywords in a search engine advertising setting),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine a bidding feature with the advertising invention of Nam because Cheung discloses that a better way to control advertising costs while maximizing advertising exposure is needed and endorses bidding price strategies that allow the advertisers to set the appropriate price for an ad thereby alleviating the costly effects of an arbitrary pricing strategy. Examiner notes that although the Cheung invention is focused on alleviating costs further in the advertising chain, i.e. controlling click-through costs, the per ad/click costs/rates in the Cheung invention are initially derived from bidding.

Claims 13 and 14:

Nam, as shown, discloses the following limitations:

- *maintaining an advertisement database for storing multiple keywords and multiple advertisement data that correspond to the keywords* (see at least page 8, line 10-12, a database that may be indexed by "key" – note that this patent uses the phrase "key word" and "key" rather than keyword),

- *receiving an access request from a user, wherein the access request includes an advertisement file stored in a user's terminal* (see at least Figure 3, Item 304),

- *extracting a keyword recorded in the advertisement file received* (see at least page 3, line 21, the information stored in the cookie may include key words, see page 3, line 25),

- *searching for the advertisement data that corresponds to the keyword by referring to the advertisement database* (see at least page 3, line 26),

- *processing the advertisement data corresponding to the keyword and providing the same to a web browser of the user* (see at least page 3, line 26-27),

- *maintaining a keyword database for storing multiple keywords and advertisement information according to the keywords* (see at least page 8, line 10-12, a database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),

- *receiving an advertisement request that includes an advertisement keyword from a sponsor, wherein the advertisement keyword corresponds to one of the multiple keywords stored in the keyword database* (see at least page 13, line 20-21),

- *searching for the advertisement information that corresponds to the advertisement keyword by referring to the keyword database* (see at least page 3, line 26),

- *recording, in the advertisement database, the advertisement keyword and the advertisement data that corresponds to the advertisement keyword* (see at least page 3, line 20).

Nam does not specifically disclose the following limitations. However, Cheung, as shown, discloses the following limitations:

- *the advertisement request is a request for purchasing the advertisement keyword by the first sponsor* (see at least column 6, lines 48-51, the advertiser 'purchases' the keyword by submitting a bid which is paid whenever the ad is displayed/clicked based on the keyword),

- *processing the advertisement information that corresponds to the advertisement keyword and providing evaluation data of the advertisement keyword to a web browser of the first sponsor* (see at least column 23, lines 22-55, "project expenses" feature of this invention predicts based on the advertisement keyword the response that an advertiser can expect, i.e. the number of clicks, and predicts the cost of the advertising campaign for the advertiser based on a cost per click payment scheme; Examiner notes that this prediction mechanism requires a determination of expected clicks based on previous data and keyword),

- *receiving a purchase response from the first sponsor, in which the purchase response includes first advertisement data of the first* (see at least column 6, line 48-51, generally describing bidding for keywords in a search engine advertising setting and advertiser providing payment for the ad),

- *providing the user interface screen to a web browser of the user such that both the first advertisement data and the second advertisement data are*

> *provided to the user simultaneously* (see at least column 7, lines 7-11,
> displaying multiple ads to a user ranked by bid amount),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine a bidding feature with the advertising invention of Nam because Cheung discloses that a better way to control advertising costs while maximizing advertising exposure is needed and endorses bidding price strategies that allow the advertisers to set the appropriate price for an ad thereby alleviating the costly effects of an arbitrary pricing strategy. Examiner notes that although the Cheung invention is focused on alleviating costs further in the advertising chain, i.e. controlling click-through costs, the per ad/click costs/rates in the Cheung invention are initially derived from bidding.

Claim 14:

Nam, as shown, discloses the following limitations:

> - *constructing a user interface screen by arranging the first advertisement data or the second advertisement data according to predetermined criteria* (see at least page 3, line 26-27, see also at least page 2, line 18, ads are displayed based on the ad table, i.e. the order),

Claim 15:

The combination Nam/Cheung discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitations:

> - *maintaining a second advertisement database for storing multiple second advertisement data that corresponds to a predetermined keyword* (see at least page 8, line 10-12, a database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),
> - *maintaining a third advertisement database for storing multiple third advertisement data* (see at least page 8, line 10-12, a database that may be

indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),

- *receiving a second keyword from the user* (see at least page 11 , lines 8-9),

- *searching for the second advertisement data that corresponds to the second keyword by referring to the second advertisement database* (see at least page 3, line 26),

- *searching for the third advertisement data by referring to the third advertisement database* (see at least page 3, line 26),

- *constructing a user interface screen by arranging the advertisement data, the second advertisement data, and the third advertisement data according to predetermined criteria* (see at least page 2, line 18, ads are displayed based on the ad table, i.e. the order),

- *providing the user interface screen to the web browser of the user reference* (see at least page 2, line 18, ads are displayed).

Claims 16 and 21:

The combination Nam/Cheung discloses the limitations as shown in the rejections above. Further, Nam, as shown, discloses the following limitations:

- *the second advertisement data is general keyword advertisement data, and a third advertisement data is general banner advertisement data (see at least page 8, line 13, banner advertisement).*

Claims 17 and 22:

The combination Nam/Cheung discloses the limitations as shown in the rejections above. Further, Nam, as shown, discloses the following limitations:

- *providing predetermined feedback information to the sponsor, in which the feedback information includes at least one of the number of times the advertisement data is provided to the user, a number of times the user clicks on the advertisement data, a time period the user visits a web page of the*

> *sponsor, and a number of times the user visits the web page of the sponsor*
>
> *after the advertisement data is provided* (see at least page 16, line 20- 21).

Response to Arguments

16.   Applicant's arguments with respect to claims 8, 10-17, 21 and 22 have been considered but are moot in view of the new grounds of rejection.

17.   Regarding the 112 1st paragraph rejection of claims 8, 13 and 14. Examiner considered Applicant's remarks with respect to this rejection, however Examiner is not persuaded. In Applicant's argument, Applicant defined the word 'evaluate' and argued that 'evaluation data' adequately describes the indented meaning for 'guiding' from the excised limitation 'guiding information.' This argument is not persuasive because the central issue in a 112 1st paragraph new matter rejection is not the definition of the disputed limitation, but rather whether the limitation was part of the original disclosure. 'Evaluation data' is a broad term that is not present in the original disclosure at all. Although Applicant's argument that 'evaluation data' can be narrowly interpreted to be consistent with the 'guiding message' of figure 7b is plausible, the original disclosure does not direct that narrow interpretation of 'evaluation data.' Examiner must apply the broadest reasonable interpretation to all claim limitations. Examiner cannot read limitations exclusive to the specification into the claims except where there is an explicit definition in the specification. Here 'evaluation data' has a broadening effect on the claims because it means more than the limited narrow interpretation Applicant suggests on pages 14 and 15 of Applicant's remarks. It is therefore new matter because is broadens the scope of the claims and because it is absent from the original disclosure.

18.   With regard to claim 19, Examiner now rejects claim 19 under 35 U.S.C. 103 as being unpatentable over Nam alone. Applicant's argument regarding functional language was not entirely persuasive as Applicant assumed that the limitations of claim 19 were functional limitations, and further Applicant relied on examples from the MPEP related to mechanical (structural) inventions, whereas Applicant's invention and the limitations of claim 19 do not

'...define structural attributes of interrelated component parts...' (from *In re Venezia* cited by Applicant, see page 16 of Applicant's remarks). With regard to the keyword database of the claim, the limitations describing the data stored in the database are non-functional descriptive material; it is merely data (see MPEP 2106). Based on Applicant's arguments, Examiner interprets the remaining limitations, disclosing various 'parts,' as software. Software is also data, but is also functional when the claim indicates that it is at least executable. The rejection of claim 19, above, indicates where each limitation is taught by Nam.

19.   Applicant's argument on page 17 describing a process of distinguishing "a sense of immediacy" from a keyword is not relevant to the claims because it is not part of the claims. Applicant argues on page 17 that Nam "does not attempt to determine whether or not a keyword is an actual interested field of a user." As shown, Nam discloses the claimed invention which requires only "determining" the interested field of the user. The claims do not disclose how that determination is made, further the specification merely includes the example Applicant repeats in Applicant's arguments on page 17 and fails to disclose how 'patent' and 'flower delivery' are distinguished by a 'sense of immediacy.' Nam assumes that the interested field of the user is the keyword that the user enters, as Applicant correctly points out on page 18 of Applicant's response. Nam's use of the keyword as the interested field of the user is a determination as required in the claim.

20.   With regard to Applicant's further arguments on page 19 of Applicant's response that various types of data are not disclosed by Nam or that various definitions of data elements are not disclosed by Nam; Examiner refers Applicant back to the rejection above. The various data elements Applicant claims are absent from Nam are not in fact as narrowly defined in the claims or in the specification as they are in Applicant's response. In fact most of the various data limitations are not defined in the specification at all. Examiner provides the broadest reasonable interpretation to the claims without reading limitations from the specification into the claims. As demonstrated by the rejection above, Examiner construed Nam, and the various data that Nam is capable of generating, processing, analyzing and storing, as teaching all of the limitations of claims 1, 18, 19, 23, 24 and 25. As noted in the rejection above, Nam teaches several apparently

distinct embodiments, and Examiner relied on teachings among these several embodiments. For this reason Examiner rejected Applicant's invention under an obviousness standard over the Nam disclosure as Examiner recognizes that Nam does not disclose a single embodiment that teaches every limitation of Applicant's claims, however as noted above, Examiner determined that a person having ordinary skill in the art at the time of Applicant's invention would have known that teachings among Nam's various embodiments could be combined yielding predictable results.

21.   Applicant's arguments regarding the Cohn reference are moot because the Cohn reference is not relied on by the current claim rejections.

22.   Applicant's amendments to claims 8, 13 and 14 are noted and the rejections have been updated (see above) accordingly. The newly added limitation further defining the 'advertisement request' is taught by Cheung (Cheung discloses pay-for-placement advertising and placing bids). Regarding Applicant's argument that Nam does not disclose 'input counter,' Examiner notes that 'input counter' is not defined in the specification, thus Examiner's previous interpretation of this limitation was that 'input counter' was yet another non-functional descriptive data element and Examiner referred generally to Nam which discloses acquiring data. Examiner now directs Applicant to various teachings of Cheung which discloses incrementing advertisement records in the database based on when they are stored and based on the bid amount and the resulting rank of the ad. Applicant's final amendment (unique to claim 14) amends the claim such that more than one advertisement is displayed to the user. Examiner relies on Cheung to teach this limitation.

Conclusion

23.   Examiner notes that the claim language is particularly challenging especially in light of the difficult phraseology and inconsistent language of the specification. Examiner encourages Applicant to contact Examiner to arrange an interview so that Examiner and Applicant may discuss how to better present the claims so that they are supported by the specification and more clearly disclose Applicant's invention.

24.   Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923.** The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST.   If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724.**

25.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.   Status information for published applications may be obtained from either Private PAIR or Public PAIR.   Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair <http://pair-direct.uspto.gov>.   Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

26.   Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

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or faxed to **571-273-8300.**

27.   Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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/Nathan C Uber/ Examiner, Art Unit 3622
20 July 2009

/Arthur Duran/
Primary Examiner, Art Unit 3622